Remarks/Arguments

Claims 18-23 were withdrawn in response to restriction requirement and claims 1-17 were elected for prosecution. Claims 1-17 are presented for consideration.

Claims Rejections – 35 U.S.C. § 101

The Examiner rejected claims 1-17 under 35 USC § 101 as directed to non-statutory subject matter, taking the position that the Applicant defined "computer-readable medium" as "a magnetic signal capable of being transferred."

Applicant traverses the Examiner's rejection of claims 1-17 and respectfully submits that the Examiner has mischaracterized the language found in paragraph [0015] of the application. Whereas Examiner is correct that "[m]agnetic signals are not patentable subject matter under 101," Applicant did not define "computer readable medium" as "a magnetic signal capable of being transferred." Instead, Applicant identified "computer readable medium" as a physical medium for storing, transferring, combining or comparing signals. In other words, a computer readable medium is indeed a tangible storage media readable by a computer. Specifically, paragraph [0017] of the published patent application states: "a computer readable medium that can direct a computer or other programmable data processing apparatus to function in a particular manner, such that the instructions stored in a computer readable medium produce an article of manufacture including instruction means that implement the functions specified in the flowchart block or blocks." Additionally, paragraph [0016] of the application states that: "These computer readable instructions may be loaded onto a general purpose computer, special purpose computer, or other programmable data

processing apparatus to produce a machine such that the instructions will execute on a computer or other data processing apparatus to create a means for implementing the functions specified in the flowchart block or blocks."

Claims Rejections – 35 U.S.C. § 112

Applicant traverses the Examiner's first rejection under § 112, stating the "language [of claims 1, 9 and 14] is unclear." Applicant respectfully submits that there is nothing unclear about "retrieving instructions for retrieving" or "receiving instructions for receiving." Applicant nevertheless agrees to the Examiner's respective interpretation of these terms as "instructions for retrieving" and "instructions for receiving."

Applicant further agrees to amend the claims 1, 9 and 14 to delete the indicated instances of the terms "retrieving" and "receiving" as shown in the foregoing Amendments to the Claims.

Applicant has read and understood the Examiner's second rejection under § 112, stating in paragraphs 7 and 9 of the Office Action that the claims are "incomplete for omitting essential elements...." or alternatively that the "updated meter information" is received by the host medium only. Applicant believes that a complete response to paragraphs 7 and 9 is possible through amendment of claim 1 and hereby amends claim 1 as shown in the foregoing Amendments to the Claims by adding the additional element of:

> instructions for updating and transmitting meter information concerning the upgrade of one of said old utility meters with a new utility meter or upgrading said old utility meters with additional components.

Applicant submits that no new matter is added by this amendment and cites as support

for this amendment the last portion of claim 14 and paragraph 9 of the specification, lines 20-22. Applicant further submits that amendment of claims 9 and 14 is unnecessary as the correct combination of limitations is already present in claims 9 and 14.

Applicant has read and understood the Examiner's remarks in paragraph 8 of the Office Action and agrees to the stated interpretation of "portable instructions." Applicant directs the Examiner to ¶ 9, lines 12-16 for further support of that interpretation.

The Examiner states in paragraph 10 of the Office Action that there is insufficient antecedent basis for the limitation "said current utility information" of claims 1 and 14. Applicant hereby amends claims 1 and 14 by adding the term "meter" as shown in the Amendments to the Claims so that the limitation reads "said current utility meter information."

The Examiner states in paragraph 11 of the Office Action that the term "logical sequence" is not defined by the claim or specification so that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant respectfully submits that the term "logical sequence" is indeed defined by the claim and specification and directs the Examiner to the language "in a logical sequence based on said location information" found in claim 2 and at paragraph [0010] of the application. These passages, when further viewed in the context of paragraph [0020], lines 15-20, make clear that a logical sequence is not simply any route as interpreted by the Examiner. A "logical sequence" is more properly interpreted as a calculated route, such as a "fast route," that is created by the billing system based upon the known addresses of each meter included in the location information. *See id.* The Applicant further

submits that a logical sequence can be any other type of route plotted in a sequence that is logical by virtue of additional considerations that a person of ordinary skill in the art would understand from reading the specification and the claims.

Applicant agrees with the Examiner's stated interpretation of the terms "scanning the updated meter information."

Claims Rejections – 35 U.S.C. § 103

The Examiner rejected claims 1-3, 5-6, 9, 11-12, 14-15 and 16 under 35 USC §103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390.

The Examiner noted as per claims 1, 9 and 14, that Milman teaches a first computer readable medium (¶ 6); a host computer readable medium with the ability to transmit data to and from said first computer readable medium (¶¶ 6 and 9); customer information embodied within said host computer readable medium containing current equipment information and location information for customers (¶ 28); a set of computer readable host instructions embodied within said host computer readable medium, including: instructions for retrieving said current equipment and location information for customers who have old equipment that requires servicing (¶ 28); instructions for transmitting said retrieved current equipment and location information to said first computer readable medium (¶28); and a set of computer readable portable instructions embodied within said first computer readable medium, including: instructions for receiving said retrieved current equipment and location information from said host computer readable medium (¶¶ 9, 10 and 28); instructions for receiving updated

equipment information concerning the servicing of one of said equipment with new equipment or servicing said old equipment with additional components (¶ 30); and instructions for transmitting said updated equipment information concerning the condition of said host computer readable medium (¶30); said set of host computer readable instructions including: instructions for receiving said updated new equipment information from said first computer readable medium; representing serviced equipment (¶ 30), and instructions for updating current information with said updated equipment information in said customer information on said host computer readable medium.

The Examiner further notes that Milman does not teach upgrading utility meters but refers to Hoffman et al. as teaching upgrading utility meters (col. 2, lines 16-29). The Examiner concluded that it would have been obvious to one of ordinary skill in the art to have modified the system of Milman using Hoffman et al. to include upgrading utility meters so as to allow a utility company to provide greater flexibility in metering electricity use, as taught by Milman at col. 2, lines 30-37.

A. Milman and Hoffman et al. cannot be combined and in fact teach away from combination.

Applicant respectfully traverses the Examiner's rejection and submits that it would not have been obvious to one of skill in the art at the time of invention to modify the system of Milman in view of Hoffman et al. In fact, these two cited references teach away from combination.

This point is supported by the fact that the Office has not provided any evidence or suggestion in Milman or Hoffman et al. of why a person of ordinary skill in the art would look to Milman in view of Hoffman et al. for solutions to the problems solved by the instant invention. *See KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740-41 (2007)

(rejecting rigid approach to obviousness analysis that leads to hindsight reconstruction of claims and unsupported combination of unrelated references); *see also Ex Parte Katoh et al.*, Appeal 20070644 (May 29, 2007) (reversing Examiner rejection for failing to provide specific evidence of any suggestion or motivation to combine the references as cited).

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The test for determination of obviousness is "whether the prior art would have suggested to one of ordinary skill in the art that the claimed [system] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). "Both the suggestion and expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Moreover, if the cited references are to be combined as the Examiner has stated, it is incumbent upon the Examiner to provide an explicit analysis regarding why the cited references should be combined. *See Ex Parte Erkey et al.*, Appeal 20071375 (May 11, 2007). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 985-88 (Fed. Cir. 2006). Applicant respectfully submits that the Examiner has not met the burden of demonstrating obviousness and would, in any event, be unable to meet any of the above-listed burdens for demonstrating obviousness largely because Hoffman et al. teaches away from the present invention.

Hoffman is directed to a specific type of "electricity meter having a protected enabling scheme for activating meter options and upgrades." (Hoffman, Abstract). Hoffman expressly states that "The present invention relates to electricity meters." Specifically, Hoffman teaches a system designed to avoid visiting or replacing utility meters (see col. 2, lines 35-36), and instead provides a system designed for remote updates through hardware contained in the utility meters. Hoffman states that: "A significant advantage of the present invention is that it allows a utility company to significantly reduce the different types of meters it must stock, since the meters of the present invention can be configured on-site to meet specific requirements." (Hoffman, col. 2, lines 30-34). Further, the ability to add options provides the utility company greater flexibility in metering electricity use *without installing new meters*. (Hoffman, col. 2, lines 34-38) (emphasis added). Hoffman, therefore, teaches away from installing new meters and rather teaches the activation of options on existing meters so that the physical travel to the electrical location is not necessary. (Hoffman, col. 2, lines 16-29).

Milman expressly states that it is directed to "a system and techniques for assigning, tracking, and billing of calls for service, maintenance and repair for customer equipment". (Milman, col.1 paragraph [00001]). Milman does not claim or disclose the upgrading or activation of options of an electricity meter through a computer system. Milman does not claim or disclose any type of electrical meter at all. Therefore, there is no motivation to combine these two reference as the teaching of these two references are unrelated with Hoffman being a type of electricity meter and Milman being a method of processing and billing work orders.

"The mere fact that the prior art may be modified in the manner suggested by the

Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). In this case, the Applicant respectfully contends that these two references, Hoffman and Milman, have no motivation for combination and therefore do not render the claims of the pending application unpatentable.

Moreover, one of the primary objects of the present invention is to provide a system designed to facilitate efficient travel to, change-out, and upgrade of utility meters. By contrast, the system disclosed in Hoffman et al. seeks to avoid traveling to and change-out of utility meters by providing remote upgrade of those meters using hardware contained in the meters. More specifically, Hoffman et al. teaches away from replacement of meters and replacement of additional components in old utility meters by instead incorporating the use of a ROM chip that includes codes for implementing one or more stored options or upgrades (Hoffman col. 2, lines 16-18). Therefore, Hoffman alone or in combination with Milman, does not claim or disclose or render the present claims obvious since Hoffman contemplates upgrading a single meter with new options or feature and **not** the replacement of existing meters with new meters as in the present invention.

Further, one of the primary objects of Hoffman et al. is, therefore, to avoid traveling to the meter for any purpose. This is the opposite of the system disclosed in the present application, which provides, *inter alia*, an improved system for replacing and upgrading meters by deliberately traveling to the meters. *See, e.g.*, ¶ 10. For these reasons, each of the cited claims should be allowable and Applicant respectfully requests reconsideration and passage of the claims to issuance.

B. Even if Milman and Hoffman could be combined they do not render the present invention obvious.

Applicant further traverses the Examiner's rejection in view of the fact that the cited references, even if combined, do not contain all of the elements of the independent claims. The Examiner stated that Milman discloses all elements of claims 1, 9, and 14, except that Milman does not teach upgrading utility meters. Applicant respectfully submits that neither Milman alone, nor the combination of cited references, discloses each of the elements cited.

More specifically, Milman does not disclose "instructions for updating current information with said updated equipment information in said customer information on said host computer readable medium" and the Examiner fails to cite any reference to support disclosure of that element in Milman. In addition, Milman fails to disclose the newly added element in the host instructions for "updating and transmitting meter information concerning the upgrade of one of said old utility meters with a new utility meter". The absence of these elements alone is believed sufficient to overcome the Examiner's obviousness rejection.

In addition, Milman fails to disclose anything regarding utility meters in either the host or portable instructions. More specifically, the following elements are missing from Milman: "receiving said retrieved current utility meter and location information from said host computer readable medium", "receiving updated meter information concerning the upgrade of one of said old utility meters with a new utility meter", and "transmitting said updated meter information to said host computer readable medium." In fact, nothing in Milman refers to utility meters for any reason.

The same deficiency is also noted with respect to claims 9 and 14. With respect

to claim 9, Milman fails to disclose computer readable instructions for "receiving customer information of customers with old utility meters transmitted from a host computer readable medium", "receiving upgraded meter information of a new utility meter to replace an old utility meter or a component used to upgrade to the old utility meter", or "transmitting said upgraded meter information to said host computer readable medium."

With respect to claim 14, Milman fails to disclose computer readable instructions for "retrieving current utility meter and location information for customers who have old utility meters that need to be upgraded to new utility meters from customer information in communication with said host computer readable medium", "transmitting said retrieved current utility meter and location information to a second computer readable medium", "receiving upgraded meter information from said second computer readable medium representing upgraded old meters" or "updating said current utility meter information with said upgraded meter information in said customer information on said host computer readable medium, to reflect updated upgrade status." Again, nothing in Milman refers to utility meters for any reason.

Without disclosure of these elements in Milman, Applicant respectfully submits that the obviousness rejection must fail. As the Examiner noted, Hoffman et al. teaches only the upgrade of ***single*** utility meters, not the replacement of ***old utility meters to new*** utility meters disclosed in independent claims 1, 9, and 14. Applicant therefore respectfully submits that the obviousness rejection cannot be maintained because neither of the cited references discloses these elements. *See In re Kahn*, 441 F.3d at 985-88 ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

C. The Dependent Claims are, therefore, patentable as dependent upon patentable independent claims.

With respect to claims 2 and 15, the Examiner states that Milman in view of Hoffman et al. teaches the system disclosed in claim 1 and that Milman further teaches "wherein said set of host computer readable instructions includes instructions for creating route information representing a list of locations where equipment needs to be serviced arranged in a sequence based on said location information." The examiner stated in paragraph 15 of the Office Action that Milman does not explicitly teach upgrading utility meters. As such, Milman alone cannot render claims 2 and 15 obvious. Nor, for the reasons stated in the preceding paragraphs, would a person of ordinary skill in the art be motivated to combine Milman with Hoffman. The additional routing limitations stated in claims 2 and 15 are, therefore, not disclosed in a properly cited combination of prior art references. Without sufficient reason or explicit analysis to demonstrate obviousness, Applicant respectfully submits that the Examiner's obviousness rejection of these and all other claims cannot be sustained.

The same is true for the Examiner's rejection of claims 3, 5, 6, 11, 12, and 16, which were each rejected for obviousness based upon Milman in view of Hoffman et al. Each of these claims were rejected in view the same two references. Because these references were not properly combined and, for the reasons stated above, Applicant requests that the Examiner reconsider and withdraw each of these rejections.

In paragraphs 21-23, the Examiner rejected claims 4 and 17 in view of Milman,

Hoffman et al., and Official Notice. Again, for the reasons stated above, Applicant submits that the underlying rejection of claims 1, 9, and 14 was based upon an improper obviousness analysis that the Applicant respectfully requests the Examiner to reconsider and withdraw. These claims are believed allowable as dependent upon the patentable independent claims.

The Examiner further rejected claims 7 and 10 based upon the combination of Milman and Hoffman et al. in view of Gall et al. U.S. Pre-Grant Publication No. 2003/0163831 A1, stating that it would have been prima facie obvious to one of ordinary skill in the art to modify the systems of Milman and Hoffman et al. to include the teachings of Gall to facilitate troubleshooting as taught by Gall in ¶ 37. Applicant traverses this rejection for the foregoing stated reasons and again respectfully submits that these claims are allowable as dependent upon patentable independent claims. In addition, Applicant submits that a person of ordinary skill in the art would not have been motivated to combine the teachings of Gall with Milman and Hoffman et al. As stated previously, Hoffman et al. teaches away from a primary object of the present invention, *i.e.*, driving to a meter for replacement or upgrade of the meter. As such, there is no motivation to combine Hoffman et al. with either Milman et al. or Gall. Applicant respectfully submits that claims 7 and 10 are, therefore, allowable.

Examiner further rejects claims 8 and 13 under 35 USC 103(a) as being unpatentable over Milman in view of Hoffman et al. and further view of Smith U.S. Pre-Grant Publication No. 2003/0220737 A1. Applicant respectfully traverses this rejection and submits that claims 8 and 13 are allowable for the same reasons stated above with respect to claims 7 and 10. Accordingly, Applicant respectfully requests that the

rejections to each of these claims be withdrawn.

Claims 1-17 are believed to be allowable for the reasons set forth above and in view of the additional limitations added in the Amendments to the Claims. Accordingly, Applicant respectfully requests that the rejections be withdrawn and that claims 1-17 be allowed. Favorable action on these remarks and passing of the case to issue is respectfully requested in due course of Patent Office business.

Respectfully submitted,

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